



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,825	11/28/2005	David W. Ashworth	13317-00001-US	7788

23416

7590

01/22/2009

CONNOLLY BOVE LODGE & HUTZ, LLP

P O BOX 2207

WILMINGTON, DE 19899

EXAMINER

SZNAIDMAN, MARCOS L

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

01/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,825

Applicant(s)

ASHWORTH ET AL.

Examiner

MARCOS SZNAIDMAN

Art Unit

1612

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-28 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-28 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's reply filed on November 3, 2008

Status of Claims

Cancellation of claims 22-25 and 29-35 and addition of new claims 36-40 is acknowledged.

Claims 26-28 and 36-40 are currently pending and are the subject of this office action.

Claims 26-28 and 36-40 are presently under examination.

Priority

The present application is a 371 of PCT/GB03/04176 filed on 09/25/2003, and claims priority to foreign application UNITED KINGDOM 0222843.5 filed on 10/02/2002.

Rejections and/or Objections and Response to Arguments

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated (Maintained Rejections and/or Objections) or newly applied (New Rejections and/or Objections, Necessitated by Amendment or New Rejections and/or Objections not Necessitated by Amendment). They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103 (Maintained Rejection)

Claims 26-28 and newly added claims 36-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over BASF AG (GB 815,538, cited by applicant) as applied to claim 22 above, and further in view of Gazzard et. al. (US 3,970,755).

The reasons for this rejection have been provided in the previous office action dated August 1, 2008, the text of which is incorporated by reference herein.

Applicant's arguments have been fully considered but are not persuasive.

Applicant argues that since the Gazzard reference teaches the use of BIT with ammonium quaternary salts in order to treat microbial infestations, it would not be obvious to the skilled in the art to combine BIT with KHDO.

Examiner's response: the Gazzard reference clearly teaches that BIT can be used alone for treating microbial infestations as can be seen in examples 1 through 12. For example in example 3 (columns 4 and 5) data is given for the treatment of square nylon meshes contaminated with *Aspergillus niger* (a microbe) with BIT alone or in combination with LBDAC. In other words, the Gazzard reference teaches that BIT is effective in treating microbial infestations.

Applicant argues that there is no motivation to combine the teachings of Gazzard and BASF, since the two teachings are independent of each other.

Examiner's response: the Gazzard reference (see above discussion) clearly teaches that BIT is effective in treating microbial infestations, in particular: *Aspergillus niger* (see Example 3) in industrial materials (square nylon meshes, see example 3).

Art Unit: 1612

BASF teaches that KHDO is effective in treating microbial infestations, in particular: *Aspergillus niger* (see Table 1 on page 2) in industrial materials (textiles, synthetic substances, etc, see page 1, lines 61-69). Combining two compositions (KHDO and BIT) that are taught in the prior art to be useful for the same purpose (protecting or treating industrial materials from microbial infestations (e.g. *Aspergillus niger*), in order to form a third composition to be used for the very same purpose would have been obvious to the skilled in the art. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Applicant then argues about the unexpected synergistic effects of the claimed combination.

Examiner's response: First: it is not clear from the data provided by applicant that there is a true synergistic effect. Applicant has not provided a mathematical formula, or a graph representation like an isobologram, that distinguishes with certainty a simple additive effect versus a true synergistic effect. Second: claims drawn to (unexpectedly) synergistic combinations of known ingredients must be factually supported by data commensurate in scope with the claims. See, *In re Kollman*, 201 USPQ 193 (C.C.P.A. 1979). (The court affirming a 103 rejection of a claim containing the word "synergistic", because the claims were not commensurate in scope with the showing of unexpected results, other than at 1:1 ratio for certain specific combinations). Applicant claims any ratio of KHDO and BIT in claim 26, from 0.001% to 10 % KHDO and BIT in claim 36, or 1 to 99% of KHDO to 1 to 99% of BIT in claim 39. In other words, applicant claims almost the entire spectra of possible ratios between KHDO and BIT. However, applicant has provided data for only two ratios (1:1 and 1:3, see page 15 of the

Art Unit: 1612

specification). So, there is no evidence that the combination of KHDO and BIT will be synergistic over the entire spectrum of claimed ranges.

Withdrawn Rejections and/or Objections

Claims rejected under 35 USC § 102

Due to applicant cancellation of claim 22, the 35 USC 102 rejection is now moot.

Rejection under 35 USC 102 is withdrawn.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1612

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/
Examiner, Art Unit 1612
January 14, 2009

/Frederick Krass/

Art Unit: 1612

Supervisory Patent Examiner, Art Unit 1612